

ESTTA Tracking number: **ESTTA262536**

Filing date: **01/24/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	Anastasia Beverly Hills, Inc.
Granted to Date of previous extension	01/24/2009
Address	438 North Bedford Drive Beverly Hills, CA 90210 UNITED STATES

Name	Anastasia Soare
Granted to Date of previous extension	01/24/2009
Address	438 N Bedford Drive Beverly Hills, CA 90210 UNITED STATES
Party who filed Extension of time to oppose	AnastasiaSoare
Relationship to party who filed Extension of time to oppose	typographical error in original input

Name	Anastasia Skin Care Inc.		
Entity	Corporation	Citizenship	California
Address	438 N Bedford Drive Beverly Hills, CA 90210 UNITED STATES		

Attorney information	John M May Anastasia Beverly Hills, Inc. 438 North Bedford Drive Beverly Hills, CA 90210 UNITED STATES Law@May.us,dchavez@dchavezlaw.com,raluca@anastasia.net Phone:(626) 355 4607
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Applicant Information

Application No	77150306	Publication date	11/25/2008
Opposition Filing Date	01/24/2009	Opposition Period Ends	01/24/2009
Applicant	ANASTASIA MARIE LABORATORIES, INC.		

	6520 North Western Avenue Suite 103 Oklahoma City, OK 73116 UNITED STATES
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Goods/Services Affected by Opposition

Class 003. First Use: 2000/05/23 First Use In Commerce: 2000/05/23
All goods and services in the class are opposed, namely: Body cream; Body lotion; Hand cream; Hand lotions; Skin cleansing lotion

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Applicant's mark as currently being used in the usual course of trade is materially different from the published mark.


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2798069	Application Date	10/27/1999
Registration Date	12/23/2003	Foreign Priority Date	NONE
Word Mark	A ANASTASIA BEVERLY HILLS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing liquid, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color pencils, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye-area creams, facial masques, facial serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions, body toners, body astringents, and		

	<p>hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, and fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances</p> <p>Class 004. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 candles</p> <p>Class 008. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 eyebrow tweezers and eyebrow grooming scissors</p> <p>Class 021. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 cosmetic brushes</p>
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U.S. Registration No.	2821892	Application Date	10/28/1999
Registration Date	03/16/2004	Foreign Priority Date	NONE
Word Mark	ANASTASIA BEVERLY HILLS		
Design Mark	<p style="text-align: center;">ANASTASIA BEVERLY HILLS</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 2000/03/00 First Use In Commerce: 2000/09/00 potpourri; cosmetics, namely, foundation, concealer, pressed powder, loose powder, eye shadow base, blush, bronzing products, eye shadows, mascara, eyeliners, lip coverings, lipstick, lip gloss, lip liners, eyebrow color products, eyebrow pencils, eyebrow powder, eyebrow pomade, eyebrow gel, nail polish, nail base coat, and nail top coat; skin care products, namely, facial cleansers, facial cleansing bars, facial toners, facial astringents, facial moisturizers, eye creams, eye gels, eye-area moisturizers, eye-area gels, eye area creams, facial masques, facial serums, facial exfoliators, body cream, body lotion, body powder, body moisturizers, body lotions, body toners, body astringents, and hand creams; body cleansing products, namely, creams, gels, and bar soaps; fragrance products, namely, perfume, eau de parfum, eau de toilette, eau de cologne, and fragranced creams, lotions, gels, bar body toners, and astringents; room fragrances</p> <p>Class 004. First use: First Use: 2000/03/00 First Use In Commerce: 2000/09/00 candles</p> <p>Class 008. First use: First Use: 2000/03/00 First Use In Commerce: 2000/08/00 eyebrow tweezers and eyebrow grooming scissors</p> <p>Class 021. First use: First Use: 2000/03/00 First Use In Commerce: 2000/08/00 cosmetic brushes</p>		

U.S. Registration No.	3503367	Application Date	02/25/2005
Registration Date	09/23/2008	Foreign Priority Date	NONE
Word Mark	A ANASTASIA BEVERLY HILLS		

Design Mark	 ANASTASIA <i>Beverly Hills</i>
Description of Mark	NONE
Goods/Services	Class 044. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Beauty salon services, namely, hair removal, dressing and styling

U.S. Registration No.	3342405	Application Date	02/25/2005
Registration Date	11/27/2007	Foreign Priority Date	NONE
Word Mark	ANASTASIA BEVERLY HILLS		
Design Mark	ANASTASIA BEVERLY HILLS		
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Beauty salon services, namely hair removal, dressing and styling		

Attachments	75833290#TMSN.gif (1 page)(bytes) 75833810#TMSN.gif (1 page)(bytes) 76632127#TMSN.gif (1 page)(bytes) 76632130#TMSN.gif (1 page)(bytes) Grounds.txt (3 pages)(6708 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John M May/
Name	John M May
Date	01/24/2009

GROUND
S FOR OPPOSITION

1. Opposer Anastasia Beverly Hills, Inc. ("ABH") is a California corporation controlled by Opposer Anastasia Soare ("AS"). ABH is the owner of record of numerous US Trademark Registrations in the fields of cosmetics and related tools and kits, and salon services, including the four cited registrations for the trademark and service mark "ANASTASIA BEVERLY HILLS".
2. "ANASTASIA" is the dominant portion of the marks in all four cited registrations. Moreover, in the cited logo variants, the word ANASTASIA is substantially larger and more prominent than the words "BEVERLY HILLS" and "Beverly Hills" is specifically disclaimed in all four cited registrations.
3. Since adoption and first use in commerce of ANASTASIA BEVERLY HILLS as a trademark and service mark in 1999, Opposer ABH, and its predecessors in interest, both themselves and through their respective licensees, have made substantial and continuous use in the regular course of trade regulated by Congress of the mark ANASTASIA BEVERLY HILLS and its logo variants on various cosmetic and skin care products in IC 3, as well as on and in connection with related tools in IC 8 and IC 12, and in connection with related services in IC 44.
4. Opposer Anastasia Skin Care Inc. ("ASC") owns and operates an "Anastasia Beverly Hills" salon in Beverly Hills, California under the supervision of Opposer AS and pursuant to a license from Opposer ABH.
5. Opposer AS is a famous esthetician who is known to the general public simply by the name "Anastasia". She has clients who come to the salon in Beverly Hills from throughout the United States and internationally and has appeared on numerous nationally broadcast television programs. Although she is best known for her expertise on the aesthetically pleasing shapes, proportions and location of eyebrows, her expertise extends to not only the eyes and face, but to the whole body, and the services she and her assistants perform in the Beverly Hills salon include application of makeup (including colored and colorless creams, powders, and gels) to eyes, lips, forehead and cheeks; manicuring and coloring of finger nails; and removal of unwanted hair from arms and legs.
6. At least as early as 1991 Opposer AS was working as a licensed esthetician who performed facials and waxings. By 1994 she had established a reputation as "Anastasia" who specialized in eyebrows, opening her own "Anastasia Salon" in Beverly Hills in 1996, which is now operated by Opposer ASC under the trade name "Anastasia Beverly Hills". By 1999, Opposer AS and a former partner had started development of a full line of cosmetics and skin care products and related tools and kits to be branded as "Anastasia Beverly Hills", which are now distributed throughout the United States by Opposer ABH.
7. Opposer AS still actively performs esthetician services for Opposer ASC and still actively participates in the development of the cosmetic products manufactured for and distributed by Opposer ABH, which are now sold through conventional and e-commerce retail channels, through trained product specialists in shopping malls and department stores, and on its proprietary website on the internet, as well as at Opposer ASC's Beverly Hills salon.
8. Opposer AS actively promotes the entire line of products distributed by Opposer ABH, and the retail outlets and customers who purchase those products identify the name "Anastasia" when used in connections with

cosmetics and skin care products, as referring exclusively to Opposer AS.

9. Applicant's application 77150306 for the mark ANASTASIA was filed in April 2007 and alleged a date of first use in May 2000. On information and belief, Applicant had not used the single name "Anastasia" as a trademark in the regular course of trade prior to 2007.

10. On information and belief, prior to 2007 Applicant did not offer for sale and did not intend to sell "cosmetics" and "skin care products" as those terms are generally understood by the relevant retailers in the cosmetics industry and their retail customers but rather promoted all its products as being "treatment products" which are "clinically proven to relieve, repair, to resurrect and to help heal the skin problems of persons with diabetes" and that they are "a professional line of diabetic products formulated by medical specialists that will not only help relieve your discomfort, but will also promote, preserve and restore you to skin health" that were distributed through specialized medical and nutritional specialists.

11. On information and belief Applicant always appends the tag line "skin therapy" or "pure skin therapy" in smaller type when using the name "Anastasia" as an indication of source or origin, and has never used the name "Anastasia" by itself as a trademark in the normal course of trade.

12. On information and belief, Applicant's president and CEO, Anastasia Marie Chehak, has never been publicly identified by the mononym Anastasia, but rather is identified by Applicant in its advertisements and press releases as either "Anastasia Chehak" or informally as "Anastasia Marie".

13. On information and belief, Applicant adopted the trademark ANASTASIA to take advantage of the reputation of Opposer AS, and to associate itself with the good will in the various products and services sold by Opposers ABH and ASC.

14. On information and belief, Applicant intends to use and has used the ANASTASIA mark on goods that are sold in the same channels of trade as Opposer ABH's products and to consumers that are familiar with and possible candidates for Opposer ASC's services in a manner which will inevitably cause confusion in the minds of Opposers' distributors, customers and clients, and which will inevitably dilute Opposers' rights in the ANASTASIA BEVERLY HILLS marks.

15. Applicant has recently introduced an "ANASTASIA EYE GEL" product that competes directly with the "skin care products, namely, *** eye gels, *** eye-area gels" listed in Opposer ABH's cited Registration 2821292, and with the "Anastasia Brow Gel" and "Anastasia Brow Enhancing Serum" products nationally distributed by ABH under the ANASTASIA BEVERLY HILLS trademark.

16. On information and belief, Applicant adopted its ANASTASIA mark knowing that Opposer AS was a living individual famous for her expertise as an esthetician commonly known by the mononym Anastasia, and that such use by Applicant would be perceived by the purchasing public as falsely suggesting that Opposer AS had endorsed Applicant's products, but made no effort to obtain and did not in fact obtain any consent from Opposer AS for such use.

/DTC JMM/

24 January 2009

Darin T. Chavez
Attorney for Opposers